

## **REMARKS/ARGUMENTS**

This is in response to the Office Action mailed July 28, 2006.

Currently pending are independent claim 38 and its dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63. Claims 22, 25-27, 29, 42-49, 51-54, 59-60, 62 and 64-68 have been withdrawn as being based on non-elected species.

### **Claim Rejections - 35 U.S.C. §103**

The Examiner has rejected claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 under U.S.C. § 103(a) as being unpatentable over Zemel et al., (FASEB J., 6/2000, v. 14, p. 1132) in view of Norman et al. (JBC 11/25/98, v. 508(27), p. 20022).

The Examiner has not established a *prima facie* case of obviousness as set forth in MPEP §§ 706.02(j) and 2143. First, Zemel et al., is not prior art to the present claims. Second, Norman does not teach or expressly or impliedly suggest any of the limitations set forth in the present claims. In addition, there is no motivation to combine this reference with other knowledge or to modify the reference to reach the claimed invention, and there would not be a reasonable expectation of success.

The Examiner asserts that Zemel et al., which has a publication date of June 2000, teaches 1-*alpha*, 25-dihydroxyvitamin D<sub>3</sub> induces an increase in calcium ion concentrations in adipocytes and a concomitant inhibition of lipolysis. However, Zemel is not prior art against the present claims; it is a subsequent publication involving the present inventors.

According to MPEP § 706.02(V)(B), any claims of a continuation-in-part of an earlier U.S. application that are fully supported under 35 U.S.C. § 112 by the earlier parent application have the effective filing date of that earlier parent application. 35 U.S.C. § 112 requires the specification to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same.

The present application was filed on December 14, 2001, as a continuation-in-part of Application No. 09/654,357 ("the '375 patent application), filed on September 1, 2000, now U.S. Patent 6,384,087 ("the '087" patent). The critical date for applying prior art is September 1, 1999 and the date of invention of the present claims is prior to June 2000. Therefore, Zemel et al. is not prior art against the present claims.

Present independent claim 38, which is directed to a method of regulating body weight comprising administering to an individual regulating body weight an antagonist of calcitrophic hormone (1,25-(OH)<sub>2</sub>-D) activity in an amount effective to block calcitrophic hormone (1,25-(OH)<sub>2</sub>-D) activity in adipocytes of said individual, said antagonist inducing weight loss, preventing weight gain and/or increasing metabolic consumption of adipose tissue, and its dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63, are fully support as required by 35 U.S.C. 112 in the parent '357 application. Support for these claims can be found throughout the text of the '087 patent, for example, column 2, lines 47-55, column 4, lines 13-17 and lines 23-45, and column 4, line 61- column 5, line 18.

Because the pending claims from this application are fully supported as set forth under 35 U.S.C. 112 in the parent application, their effective filing date is September 1, 2000, and therefore, the critical date is September 1, 1999, which predates the Zemel reference publication date of June 2000, and therefore the Zemel reference is not prior art.

The Examiner further asserts that Norman teaches "that 1-*beta*, 25-dihydroxyvitamin D<sub>3</sub> is an antagonist of the 1-*alpha* compound, particularly [sic, and] calcium ion uptake."

The present invention is distinct from Norman, which does not disclose, teach or suggest any

of the elements of independent claim 38. Norman does not teach, disclose or suggest a method of regulating body weight comprising administering to an individual regulating body weight an antagonist of calcitrophic hormone (1,25-(OH)<sub>2</sub>-D) activity in an amount effective to block calcitrophic hormone (1,25-(OH)<sub>2</sub>-D) activity in adipocytes of said individual, said antagonist inducing weight loss, preventing weight gain and/or increasing metabolic consumption of adipose tissue, as set forth in the present claims.

The Examiner further contends that it would have been obvious to one of ordinary skill to use the 1-*beta* compound to control weight in view of Zemel. However, this contention is moot because Zemel is not prior art to the present claims and Norman does not teach or suggest controlling weight, inhibition or promotion of lipolysis or weight loss.

The Examiner contends that as to the claimed reduction in risk of coronary artery disease, one of ordinary skill will recognize that weight loss will reduce the risk of said disease. However, this contention is moot because Zemel is not prior art to the present claims.

Further, the cited art does not disclose, teach or suggest the claimed invention as set forth in dependent claims 21, 23-24, 35-37, 39-41, 50, 55-58, 61 and 63. These include additional limitations distinguishing them from the cited references.

Claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 are patentable because none of the cited references or material disclose, teach or suggest the present invention.

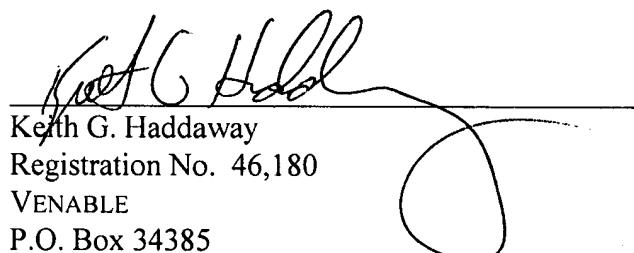
### Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims 21, 23-24, 35-41, 50, 55-58, 61 and 63 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

  
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